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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,536	06/29/2000	Earl A. Hubbell	AFFYP007X1C1	1335

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT PAPER NUMBER

1655

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/607,536

Applicant(s)
Hubbell et al

Examiner
Jeffrey Fredman

Art Unit
1655



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 29, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 and 24-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Specification

1. A substitute specification including claims is required pursuant to 37 CFR 1.125(a) because insufficient space was left at the top of the page to permit hole punching into the file jacket. Therefore, every page has text which is obscured by holes punched into them. While the examiner is able to examine the case, it will not be adequate for printing if the patent is issued.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Claim Rejections - 35 USC § 112

2. The rejection of claim 9 under 35 U.S.C. 112, second paragraph, is withdrawn in view of the invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8-10 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Socransky et al (Biotechniques (1994) 17(4):788-792).

Socransky teaches a substrate, which is a nylon membrane (page 788, column 2), with nucleic acid probes coupled onto the membrane (page 788, column 2) comprising:

a) a plurality of regions on the substrate in which diverse polymer probes are coupled in a checkerboard pattern, see page 789, figure 3, where it is clear that the interacting probes form a checkerboard pattern and for purposes of the rejection, the membrane after hybridization is the anticipatory product, since it has 43 regions loaded with different polymer probes (page 789, figure 3) and,

b) a plurality of regions on the substrate in which the polymer probes having the same sequence are coupled and the array also clearly has many regions in which polymer probes having the same sequence are coupled (page 789, figure 3). Thus, for example, the first column of the array has 43 different polymer probes and the entire column has the same sequence probe "371". The second column has 43 different polymer probes and the entire column has the same sequence probe "1219".

Finally, at least some of the plurality of regions are near the center of the substrate, and because "near" is a relative term as discussed in the 112, second paragraph rejection above, all of the regions might be "near" the center.

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The limitation regarding the monomer addition cycle simply represents "product by process" type limitations on the product. As MPEP 2113 notes "Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps." Here, where no particular structure is implied by the steps other than that the sequences are different in some way, the cited prior art meets the structural limitations of the claim.

Response to Arguments

5. Applicant's arguments filed November 29, 2001 have been fully considered but they are not persuasive.

Applicant requests that text from the parent application be used. This is not possible, however, applicant may defer correction of this issue until the application is otherwise in condition for allowance.

Applicant argues that Socransky does not teach polymer probes having the same sequence which are formed with at least one different monomer addition cycle. This argument is incorrect because it misinterprets the claim. The oligonucleotides on the solid support need not differ by a monomer addition cycle. The argued limitation is drawn to a control sequence, which control sequence is NOT part of the substrate having polymer probes. For example, if probes 1 and 2 are bound to the solid support, and a probe 3 is used to test the integrity of probes 1 and 2, probe 3 has no structural impact or patentable weight with regard to a product which claims probes 1 and 2 bound to the solid support, since the probe 3 requirement imposes no structural limitation on

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the substrate comprising probes 1 and 2. The substrate will be the same whether probe 3 is later used to test the integrity or not. Thus, applicant's argument is not found persuasive.

Applicant's citation of figure 12 of the specification is unavailing, because the resultant difference is, as noted by the specification, a result of hybridization a control sequence. Thus, the structural difference in figure 12 is not related to the claim, because in the Socransky paper, the probes attached to the support meet the claim limitations, irrespective of the later hybridization of a control sequence. A method claim would impose these limitations, but this product claim cannot.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman, Ph.D. whose telephone number is (703) 308-6568.

The examiner is normally in the office between the hours of 6:30 a.m. and 4:00 p.m., and telephone calls either in the morning are most likely to find the examiner in the office.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission via the P.T.O. Fax Center located in Crystal Mall 1. The CM1 Fax Center numbers for Technology Center 1600 are either (703) 305-3014 or (703) 308-4242. Please note that the faxing of such papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).


Jeffrey Fredman
Primary Patent Examiner
Art Unit 1637

January 30, 2002